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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/900, 735 07/24/97 NORTHRUP M 07043/015007

<input type="checkbox"/>	<input type="checkbox"/>	EXAMINER
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HM12/0826

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ART UNIT	PAPER NUMBER
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1653

11

DATE MAILED:

08/26/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

<b>Office Action Summary</b>	Application No. <b>08/900,735</b>	Applicant(s) <b>Northrup et al</b>
	Examiner <b>Jeffrey Siew</b>	Group Art Unit <b>1653</b>

Responsive to communication(s) filed on Jul 15, 1999

This action is **FINAL**.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

#### Disposition of Claims

Claim(s) 1 and 93-121 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

Claim(s) \_\_\_\_\_ is/are allowed.

Claim(s) 1 and 93-121 is/are rejected.

Claim(s) \_\_\_\_\_ is/are objected to.

Claims \_\_\_\_\_ are subject to restriction or election requirement.

#### Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. § 119

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All  Some\*  None of the CERTIFIED copies of the priority documents have been received.

received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

#### Attachment(s)

- Notice of References Cited, PTO-892
- Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- Interview Summary, PTO-413
- Notice of Draftsperson's Patent Drawing Review, PTO-948
- Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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## **DETAILED ACTION**

### ***Location of Application***

1. The location of the subject application has changed. The subject application is now located in Group 1650, Art Unit 1653, and is assigned to Patent Examiner Jeffrey Siew.

### ***Drawings***

2. The Figures are objected to for reasons as stated on the PTO-948 mailed 1/15/99 paper No. 7. Applicant is required to submit a proposed drawing correction in response to this Office action. However, correction of the noted defect can be deferred until the application is allowed by the examiner.

### ***Claim Rejections - 35 USC § 102/103***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

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4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 1 and 93-121 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over either Wilding et al., (US Patent 5,486,335; Wilding I) or Wilding *et al.*, (US Patent 5,498,392; Wilding II). Wilding et al., (US Patent 5,486,335; Wilding I) or Wilding *et al.*, (US Patent 5,498,392; Wilding II).

Wilding I and Wilding II disclose an instrument or microfabricated device. Said instrument can be used in performing polymerase chain reaction (PCR); that the sample can be of intact cells, lysed cells, or cellular components, e.g., nucleic acid. The device is synthesized in a

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solid substrate or "chip" (column 3 and 4) and may contain chambers and connecting channels of various depths and dimensions (column 3). Detection means are disclosed at column 4, bridging to column 5; and at columns 11-12. Means for treating a cell sample are disclosed at column 13. Performance of polymerase chain reaction is disclosed at column 15. The use of a microprocessor in combination with the device is disclosed throughout, see *e.g.*, columns 9 and 10. Means for delivering fluids to the chip are disclosed at column 8, last paragraph; column 10, third paragraph. The incorporation of immuno-based reagents so to facilitate detection of target nucleic acid sequences is disclosed at column 11.

*Response to Amendment*

6. The declaration filed on 7/15/99 under 37 CFR 1.131 has been considered but is ineffective to overcome the Wilding et al (US 5,486,335 Wilding I) and Wilding et al (US 5,486,335 Wilding I) references.

The declaration has not been signed by all applicants. The 102/103 rejections over claims 1 and 93-121 are maintained.

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## **SUMMARY**

7. No claims allowed.

## **CONCLUSION**

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey Siew whose telephone number is (703) 305-3886 and whose e-mail address is [Jeffrey.Siew@uspto.gov](mailto:Jeffrey.Siew@uspto.gov). The examiner can best be reached on Monday through

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Thursday from 6:30 a.m. to 4 p.m. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brad Sisson, can be reached on (703) 308-3978.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist for Technology Center 1600 whose telephone number is (703) 308-0196.

Papers related to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to Group 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The CM1 Center numbers for Group 1600 are Voice (703) 308-3290 and Fax (703) 305-3014 or (703) 305-4242.

*J. Siew*  
Jeffrey Siew

August 25, 1999

KENNETH R. HORLICK  
PRIMARY EXAMINER  
GROUP 1600 8/25/99

*Kenneth R. Horlick, Ph.D.*